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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,727	10/26/2001	John E. Sims	3151-A	9375

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IMMUNEX CORPORATION
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EXAMINER

LI, RUIXIANG

ART UNIT PAPER NUMBER

1646

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/061,727

Applicant(s)

SIMS ET AL.

Examiner

Ruixiang Li

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1, 2 and 7.

Claim(s) objected to: _____.

Claim(s) rejected: 5, 6, 9-11.

Claim(s) withdrawn from consideration: 3, 4, 8, and 12-14.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The amended claims 10 and 11 are in improper form because they are multiple dependent claims. See MPEP 608.01 (n).

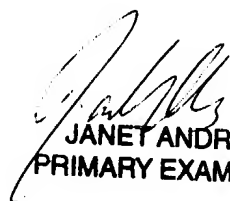
Continuation of 3. Applicant's reply has overcome the following rejection(s): If the amendment were entered, the rejection of claims 5, 6, 9, and 10 under 35 U.S.C. 112, 1st paragraph for written description would be overcome.

Continuation of 5. does NOT place the application in condition for allowance because: the rejection of claims 5 (part h), 6, 9, and 10 under 35 U.S.C. 102(b) as being anticipated by Huang et al. (Proc. Natl. Acad. Sci. USA 94:12829-12832, 1997) and the rejection of claims 5 (part h), 6, 9, and 10 under 35 U.S.C. 102(e) as being anticipated by Cao (US Patent No. 6,280,955) are maintained.

Applicants argue that the amended claim 5 recites high stringency hybridization conditions and the rejections should be withdrawn. This is not persuasive because the cDNA taught by Huang et al. or Cao shares 100% sequence identity with the nucleotides 1 to 1354 of SEQ ID NO: 1. Thus, it is expected that the cDNA hybridizes to the nucleic acid sequence of SEQ ID NO: 1 under stringency hybridization conditions. Since claim 5, a b, e, g encompasses SEQ ID NO: 1, the references of Huang et al. or Cao meets the limitations of claim 5 and its dependent claims.

The Examiner acknowledged that the rejection of claims 5 (part h), 6, 9, and 10 under 35 U.S.C. 102(b) as being anticipated by Huang et al. was written as "the rejection of claims 5, 6, 9, and 10 under 35 U.S.C. 102(b) as being anticipated by Saeki et al. (Database Swiss-Prot, Accession No. P35413, November 1, 1997)" by mistake.

The objection of claims 5, 6, 9, and 10 for reciting unelected subject matter related to SEQ ID NO: 4 is maintained. Applicants have not amended claim 5 to remove the unelected subject matter. Appropriate correction is required.


JANET ANDRES
PRIMARY EXAMINER